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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055460
Party	Plaintiff The Hackett Group, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 3,878,276  
For the mark "HACKETT CONSULTING"

_____	)	
THE HACKETT GROUP, INC.,	)	
	)	
Petitioner,	)	
	)	
vs.	)	Cancellation No. 92055460
	)	
HACKETT CONSULTING, LLC	)	
	)	
Registrant.	)	
_____	)	

PETITIONER'S BRIEF

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**PETITIONER'S BRIEF ON THE CASE**

Petitioner, the Hackett Group, Inc., ("Petitioner") hereby petitions to cancel U.S. Registration No. 3,878,276 for "HACKETT CONSULTING" ("the HACKETT CONSULTING Registration") for use in connection with "*branding services, namely, consulting, development, management, and marketing of brands for businesses*", in International Class 35.

As set forth below, the HACKETT CONSULTING Registration is likely to cause confusion with U.S. Registration No. 3,064,697 for THE HACKETT GROUP and Petitioner's family of common-law trademarks incorporating the leading term "HACKETT", all of which have been used in connection with Petitioner's competing business consulting services since at least as early as 1992.

**I. DESCRIPTION OF THE RECORD**

The evidence of record in this proceeding consists of the following:

- a. Petitioner's Notice of Reliance filed June 13, 2013, containing a status and title copy of U.S. Registration No. 3,064,697, printed and electronic publications, and Registrant's Discovery Responses (Pet. Exs. 1-34);
- b. Petitioner's Second Notice of Reliance filed June 17, 2013, containing printed and electronic publications (Pet. Exs. 35-37);
- c. Testimony deposition of Anthony Snowball;
- d. Exhibits 1-16, introduced during the testimony deposition of Anthony Snowball;
- e. Testimony deposition of Registrant's principal, Aaron Hackett; and
- f. Registrant's Exhibits A-C, introduced during the testimony of Aaron Hackett.

## **II. STATEMENT OF THE ISSUES**

Whether U.S. Registration No. 3,878,276 for HACKETT CONSULTING is likely to cause confusion, mistake or deception as to the source of Registrant's services or as to Registrant's affiliation, connection, or association with Petitioner, or as to Petitioner's sponsorship or approval of Registrant's services.

## **III. RECITATION OF FACTS**

### **A. Overview of Petitioner.**

Petitioner is an advisory and consulting firm with offices throughout the United States, Europe, and Asia. Pet. Ex. 4.; (Snowball Dep. 7:22-25-8:1-2, 74:18-25-75:1-16). Since at least as early as 1992, Petitioner and its predecessors-in-interest have continuously

used THE HACKETT GROUP mark in commerce in connection with business consultation and analysis services. (Snowball Dep. 9:3-8). These services are rendered within "any conceivable field of business." (Snowball Dep. 14:3-4). Petitioner has served as a consultant to over 3,000 clients, many of which -- such as AT&T, BP, IBM, Pfizer, Toyota, and Walmart -- are among the world's largest companies. Pet. Ex. 4; Snowball Dep. 85:6-14 and corresponding Exhibit 7, at PET 490.) Nevertheless, while Petitioner's "business is focused on preeminent brands . . . [it can] scale down to the smallest of companies." (Snowball Dep. 13:13-17). Since going public in 1998, Petitioner has been publicly traded on the NASDAQ exchange under the ticker symbol "HCKT". (Snowball Dep. 85:6-14 and corresponding Exhibit 7, at PET 489.)

The strength of THE HACKETT GROUP mark is magnified by its membership within a larger family of common-law trademarks, such as THE HACKETT PERSPECTIVE, HACKETT BEST PRACTICES, and HACKETT TECHNOLOGY SOLUTIONS, making common use of the leading term "HACKETT" (collectively the "HACKETT Marks".) (Snowball Dep. 36:8-13, 72:21-25-74:1-2, 96:19-22). For over twenty (20) years, the HACKETT Marks have been used and promoted together in a manner that has led the public (1) to associate not only THE HACKETT GROUP, but also the HACKETT Marks, with Petitioner and Petitioner's services; and (2) to recognize "HACKETT" as a distinct feature originating with Petitioner.

Petitioner is the owner of incontestable U.S. Trademark Registration No. 3,064,697 for THE HACKETT GROUP for use in connection with "business consultation and analysis services, namely, providing



surveys and analysis reports in the nature of best practices and benchmarking of business processes" in International Class 035, with a corresponding nationwide priority date of January 1992. Prior to commencing this action, Petitioner filed four (4) applications with the United States Patent and Trademark Office ("PTO") to register HACKETTCONNECTOR (Serial No. 85/348,187) for use in connection with "web based tools used for the purpose of analyzing operational metrics and performance trends" in International Class 009; HACKETT PERFORMANCE EXCHANGE (Serial No. 85/348,179) for use in connection with "web based tools used for the purpose of analyzing operational metrics and performance trends"; THE HACKETT HIGHWAY (Serial No. 85/351,273) for use in connection with "business consultation services in the nature of best practices and benchmarking of business processes" in International Class 035, with the United States Patent and Trademark Office ("PTO"); and HACKETT HD (Serial No. 85/715,810) for use in connection with "business consultation services, namely, providing surveys and analysis reports in the nature of best practices and benchmarking of business processes" in International Class 035 ("Petitioner's Applications".) Each of Petitioner's Applications has received a Section 2(d) refusal prefaced on the HACKETT CONSULTING Registration.

B. Overview of Registrant.

Registrant, Hackett Consulting, LLC, is a Limited Liability Company owned by Aaron Hackett. (A. Hackett Dep. 8:3-15). Prior to forming Hackett Consulting, LLC, Aaron Hackett served as Senior Brand Manager at Proctor & Gamble and Senior Marketing Manager at ConAgra

Foods, Inc.<sup>1</sup> (A. Hackett Dep. 5:20-22). In 2008, Registrant began using HACKETT CONSULTING in connection with brand consulting, development, management, and marketing services for businesses. (A. Hackett Dep. 8:3-9:4 and corresponding Exhibit A.) Although based in Georgia, Registrant markets itself to a national client base and, according to Registrant's website, has worked with major brands such as Bounce and Roto-Rooter. (A. Hackett Dep. 54:21-55:6, 61:3-9 and corresponding Exhibit C).

On December 12, 2009, Registrant applied to register HACKETT CONSULTING for use in connection with "branding services, namely, consulting, development, management and marketing of brands for businesses and/or individuals" in International Class 35, with a corresponding first use date of June 2008. The Examining Attorney assigned to Registrant's Application required a disclaimer of "CONSULTING" on the basis that "it is the generic name of the services as shown in the identification of services and specimen of use." See Reg. No. 3,878,276, Office Action, dated March 15, 2010. The HACKETT CONSULTING Registration subsequently issued on the Supplemental Register in conjunction with a disclaimer of the term "CONSULTING."

C. Petitioner's HACKETT Marks

i. THE HACKETT GROUP

Petitioner's first use of THE HACKETT GROUP in connection with business consultation and analysis services occurred at least fourteen (14) years prior to the date of first use claimed in the HACKETT CONSULTING Registration. Since that time Petitioner has continued to

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<sup>1</sup>It bears noting that ConAgra is identified as one of Petitioner's corporate clients on Petitioner's website. (Exhibit 7 to Snowball Dep., at PET 490.)

extensively use, advertise, and promote THE HACKETT GROUP mark in connection with a broad array of business services. Petitioner maintains U.S. offices in Atlanta, Chicago, Miami, New York, Philadelphia, and San Francisco, as well as several international offices in Amsterdam, Budapest, Frankfurt, London, Hyderabad, Paris, and Sydney. Pet. Ex. 4. From 2000 to 2008, Petitioner's services generated yearly revenues in the range of \$132 Million and \$296 Million per year. Pet. Exs. 9-12; see also (Snowball Dep. 82:19-25, 83:1-5 and corresponding Exhibit 6.) Consequently, Petitioner held a dominant role in the business consultation and analysis field well-before Registrant's began using HACKETT CONSULTING in connection with its overlapping services.

The head of Petitioner's Global Benchmarking Practice, Anthony Snowball, has testified that THE HACKETT GROUP mark is "used on all of [its] materials, whether they are sales materials, client training materials, communication materials, presentation materials [or] contracting documentation." (Snowball Dep. 8:23-25-9:1-2, 18:12-18). THE HACKETT GROUP mark is also prominently featured on Petitioner's Annual Reports which are provided to "shareholders and made available publicly over the web." (Snowball Dep. 89:11-18)

Since 2011, Petitioner has hosted an annual *Best Practices Conference*. Last year, the New York Times reported that Petitioner's 2013 conference would be attended by "senior executives from nearly a dozen of the world's largest and most successful companies, including Citigroup, General Electric, General Mills, Kimberly-Clark, MetLife, Office Depot, and DE Connectivity - discussing their efforts to

improve efficiency and effectiveness in finance, HR, procurement, IT and other business services." (Snowball Dep. 91-93:18-25, 94:1-15 and corresponding Exhibits 12 and 13); see also Pet. Exs. 24-27. THE HACKETT GROUP mark was prominently used throughout the conference and on all presentation materials. (Snowball Dep. 61:22-25, 62:1-25).

Due to the nature of Petitioner's services, individuals at all levels of a company's hierarchical structure -- beginning with the upper-level executive initially hiring Petitioner -- may be exposed to the HACKETT GROUP mark. (Snowball Dep. 43:2-7, 64:12-19). Specifically, Petitioner's consultants interact with "virtually the entire organization that [it is] benchmarking or optimizing through consulting." (Snowball Dep. 21:11-15, 24:11-25). Petitioner's communications with a client's employees - whether verbal or printed in an email, memorandum, questionnaire or presentation - will always reference the HACKETT GROUP Mark to ensure "there's no ambiguity as to who [employees are] dealing with." (Snowball Dep. 21:20-25 - 22:1-5, 23:13-21). The HACKETT GROUP Mark is also prominently featured on final reports sent to clients which are, subsequently, often internally distributed throughout the organization. (Snowball Dep. 79:18-25-80:1-12, and corresponding Exhibit 5). As a result, recognition of THE HACKETT GROUP mark penetrates wide array of departments (including marketing and branding), regardless of employment title. (Snowball Dep. 25:4-7, "as a rule, it is safe to say that we touch executive, mid-level, and . . . lower-level employees"; and 43:2-7)

Much of Petitioner's client development comes from referral sources and word-of-mouth testimony. (Snowball Dep. 14:5-22). In fact, Anthony Snowball testified that Petitioner has on occasion been retained by a former client's employee who left a large company for a smaller one (and vice versa.) (Snowball Dep. 114:20-25 - 115:1-6).

Industry recognition of THE HACKETT GROUP mark has also been bolstered by Petitioner's practice of periodically contacting former clients to "keep tabs on their progress". (Snowball Dep. 60:2-22, 61:1-5). This includes, for instance, providing former clients with research materials tailored to their specific needs. Id. As these communications and materials all bear THE HACKETT GROUP mark, the practice ensures that Petitioner's HACKETT Marks continue to be recognized well after its services are rendered.

ii. The HACKETT Family of Marks.

The strength of THE HACKETT GROUP mark is magnified by its membership within a larger family of common law marks which share the leading term HACKETT. Petitioner was extensively using and promoting the HACKETT Marks to the public well before Registrant's first use of HACKETT CONSULTING. Beginning in 2003, Petitioner began circulating "THE HACKETT PERSPECTIVE" "featuring topics related to business consultation and analysis, including best practice analysis, survey results, case studies and management issues." See Pet. Ex. 2; (Snowball Dep. 9:15-18). THE HACKETT PERSPECTIVE is distributed to Petitioner's prospective clients, current customers, Petitioner's employees, and attendees of Petitioner's conferences. (Snowball Dep. 10:3-9).

As Anthony Snowball testified, the use of "HACKETT" as a shorthand for THE HACKETT GROUP is "very common". (Snowball Dep. 36:8-13, 72:21-25-74:1-2, 96:19-22). An archived copy of Petitioner's website from November 2002 features use of (1) HACKETT BEST PRACTICES; HACKETT BENCHMARKING; HACKETT COLLABORATIVE LEARNING; and HACKETT HIGHWAY; and (2) the phrase "Since 1988, Hackett has helped companies use benchmarking to create a roadmap." Pet. Ex. 5. Petitioner's 2003 website references "HACKETT's unparalleled benchmark database", as well as several of the HACKETT Marks, including, HACKETT HIGHLIGHTS and HACKETT BUSINESS-VALUE INDEX. Pet. Ex. 6. An archived copy of Petitioner's May 2006 website includes the headline "CNBC Europe interviews Hackett Chief Research Officer on Compliance Costs" as well as a reference to "Hackett's 2005 Book of Numbers". Pet. Ex. 7. Petitioner's more recent websites continue to utilize headers such as "HACKETT in the news" and marks that include HACKETT PERFORMANCE EXCHANGE; HACKETT TECHNOLOGY SERVICES; HACKETT CERTIFIED; HACKETT'S KNOWLEDGE REPOSITORY. Pet. Ex. 4; (Snowball Dep. 35:25 - 36:1-2 and corresponding Exhibit 3 at p.2, and Exhibit 7 at PET 500). Petitioner's Annual Reports, which are provided to shareholders and made available publicly over the web, have also made frequent references to the HACKETT Marks. Petitioner's 2005 Annual Report, for instance, included a letter to shareholders referencing the "expanding Hackett brand" and discussing the need to "build our Hackett brand". See Pet. Ex. 17;

It is no surprise, then, that third-parties also frequently use the base term "HACKETT" to identify Petitioner and/or the source of

Petitioner's services. These include, by way of example, a 2003 news release by Accenture (*"Hackett will be able to broaden the base [of its metrics]; 'Hackett's benchmarks'"*), Pet. Ex. 18, a 2002 article in the South Florida Business Journal (the *"Hackett Organization"*; *"Barlag has already begun to expand the Hackett sales force"*), Pet. Ex. 19, an article published by both Business Wire and Reuters in January 2008 (*"Hackett offers working capital solutions."*) Pet. Ex. 20, p.2 and Pet. Ex. 21; and 2013 write-up in the New York Times (*"Hackett offers working capital solutions focused on delivering cash flow improvements. . . . Hackett offers business application consulting services that help maximize returns on information technology investments."*) Pet. Ex. 27; (Snowball Dep. 96:1-22 and corresponding Exhibit 15). All of these stories remain publicly available on the internet. See Pet. Exs. 18-28.

As shown above, for over two decades, Petitioner's promotional and branding efforts have built a foundation around the leading term "HACKETT". As a result, the term "HACKETT" has (1) acquired distinctiveness in relation to Petitioner's services; and (2) become a recognizable common characteristic associated exclusively with Petitioner and Petitioner's services. See, e.g., Black & Decker Corp. v. Emerson Electric Co., 84 U.S.P.Q.2d 1482, 1490 (TTAB 2007) (noting that the owner of the series of marks acquires an exclusive right to the common family element where a "pattern of usage of the common element is sufficient to be indicative of the origin of the family"); Marion Laboratories v. Biochemicals Diagnostics, 6 U.S.P.Q. 1215, 1219-19 (TTAB 1998).

#### D. Petitioner's Services

As set forth in THE HACKETT GROUP Registration, Petitioner's services consist of "business consultation and analysis services, namely, providing surveys and analysis reports in the nature of best practices and benchmarking of business processes." Petitioner is generally retained by a company seeking "to optimize cost or improve overall performance." (Snowball Dep. 15:2-16). Once retained, Petitioner's consultants interact with a company's employees to identify the practices currently in place for executing a business process and how well these practices are performing. (Snowball Dep. 10:13-16). This information is then measured against a "defined set of metrics" in order to (1) provide the client a benchmark of its current performance; (2) give "an indication of whether their performance was strong or weak relative to the comparison that was used"; and (3) determine "the optimal way", the "best practices", for executing the process. (Snowball Dep. 10:16-24, 11:14-17, 12:1-2, 15:13-16). Once the benchmarking and best practices analysis is complete, the company may thereafter engage Petitioner as a consultant to "fix" the problem. (Snowball Dep. 13:13-24, 56:20-25 - 58:1-25). The goal is, ultimately, to "help [a company] operate more efficiently and ideally [at] a world-class level." (Snowball Dep. 10:16-24, 15:13-16).

Petitioner's benchmarking and optimization services can target a wide range of business functions including "finance, human resources, IT, procurement, marketing, [and] sales and service." (Snowball Dep. 16:13-25). They may also target processes falling within one of these functions, such as "brand management." The scope and depth of



Petitioner's analysis are "customized" and "dictated" by the client. (Snowball Dep. 71:15-25- 72:1-20). Accordingly, while one client might request an analysis of its entire business, another may want to narrowly evaluate "how effectively the brand is driving traffic to the website". (Snowball Dep. 12:5-14, 13:4-9, 44:12-23, 45:20-22).

Petitioner may, for instance, be retained in order to identify the best way to "promote, position, and optimize [a] brand" or to evaluate "the performance of the brands in total." (Snowball Dep. 43:13-25, 46:4-18). In conducting this analysis, Petitioner will interact with individuals within a marketing department, such as brand managers or web developers, either directly or as part of the evaluation process. (Snowball Dep. 43:2-7; 45:20-25). If a website's "usability" is identified as a weakness, Petitioner's consultants may thereafter work directly with the "VP of website design [and] their project team" to develop and improve that website. (Snowball Dep. 11:9-11, 57:24-58:16). Alternatively, Petitioner might make prescriptive recommendations on (1) "how to tailor . . . products and services to [a particular] demographic", (Snowball Dep. 49:1-19, 35:10-18); or (2) "how to allocate "sales and marketing resources by . . . by brand and by product" (Snowball Dep. 70:17-25-71:1-13). Consequently, it is hardly unusual with employees on "the creative side", such as web developers or employees responsible for "brand and product management". ((Snowball Dep. 42:5-25, 43:1-7.)

#### E. Registrant's Use of HACKETT CONSULTING

The HACKETT CONSULTING Registration identifies Registrant's services as "brand consulting, development, management, and marketing services

for businesses." As Registrant's principal, Aaron Hackett, concedes: "brand management is a broad term". (A. Hackett Dep. 10:23-11:8). Specifically, Registrant's principal identifies the core functions of brand management as follows:

I break [them] into four. The first one I look at is assessing the landscape, the competitive landscape... The second thing is in the context of that landscape, how do you position your brand? ... The third think I look at is execution strategy... And then finally there's the actually execution, the work that is done, the marketing work that is done. (A. Hackett Dep. 10:23-11:8).

Registrant's principal defines "assessing the landscape" as taking a "broad look at the competition [which] can tell you what trends are. *It could be benchmarking.*" (A. Hackett Dep. 12:5-11) (emphasis added). According to Registrant's principal:

I would say [to the client], so who's the competition? And it's important to understand those things like that so you can figure out what message to communicate. So when we do a Facebook ad, I can talk about, hey this is how you're better than somebody else. (A. Hackett Dep. 43:13-19).

Like Petitioner, Registrant will "lay out the strategies of the execution, but . . . typically execute also." (A. Hackett Dep. 11:25-12:1). Registrant may, for instance, evaluate a client's social media presence and provide adjustments based on that data. (A. Hackett Dep. 13:15-16:8, 48:9-49:12).

Like Petitioner, Registrant is typically hired by an executive or owner of a company but will, thereafter, interact with lower level employees during the planning and execution phase. (A. Hackett Dep. 56:14-24, 57:13-18, 58:6-22). Like Petitioner, Registrant's client base is established primarily through word of mouth and referrals. (A. Hackett Dep. 16:15-24).

#### IV. ARGUMENT

Pursuant to 15 U.S.C. §1052(d), a mark may not be registered on the Principal Register

"[W]hich so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive."

In an *inter partes* cancellation proceeding, the likelihood of confusion analysis focuses on the factors set forth in In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Specifically, the following factors - when of record - must be considered in any determination as to the likelihood of confusion between two marks: (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the

extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether *de minimus* or substantial; and (13) any other established fact probative of the effect of use. Id.

Applying the DuPont factors to the present facts reveals a strong likelihood that the HACKETT CONSULTING Registration, when used in connection with Registrant's services, will create consumer confusion relative to THE HACKETT GROUP Registration and the HACKETT Marks. Furthermore, any doubts as to the likelihood of confusion should be resolved in favor of the senior user as "the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so." In re Shell Oil Co., 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); see also Dr. Seuss Enterprises, L.P. v. Penguin Books, USA, Inc., 109 F.3d 1394, 1404 n.14 (9<sup>th</sup> Cir. 1997).

Of the DuPont facts, the similarity of the marks and the relatedness of the underlying services comprise the "fundamental inquiry" of the likelihood of confusion analysis. See Federated Foods v. Fort Howard Paper Co., 544 F.3d 1098, 192 USPQ 24, 29 (CCPA 1976). Consequently, although all of the DuPont factors should be afforded weight, Petitioner's analysis focuses primarily "on dispositive factors, such as similarity of the marks and relatedness of the goods." See Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d at 1265, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (quoting Han Beauty, Inc. v. Alberto-Culver Co., 236 F.3d 1333, 1336 (Fed. Cir. 2001).)

A. Similarity of the marks.

"The first part of a mark . . . is most likely to be impressed upon the mind of a purchaser and remembered." Presto Products, Inc. v. Nice-Pack Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988); Century 21 Real Estate Corp. v. Century Life of Am. V. Century Life of Am., 23 USPQ2d 1968, 1970 (Fed. Cir. 1992). For this reason, the first term of a mark is generally considered dominant and afforded considerable weight in assessing the similarity between two marks. See Palm Bay Imports, Inc. v. Venue Clicquot, 73 U.S.P.Q. 2d 1689, 1690 (Fed. Cir. 2005). As evidenced by the disclaimers of "GROUP" and "CONSULTING" in THE HACKETT GROUP and HACKETT CONSULTING Registrations, "HACKETT" is the most salient and distinctive portion of parties' marks. Further, as previously discussed, for over twenty (20) years Petitioner has used and promoted the HACKETT Marks together in a way that has resulted in a "synergistic recognition [of HACKETT] that is greater than the sum of each mark." Quality Inns Int'l, Inc. v. McDonald's Corp., 695 F. Supp. 198, 212 (D. Md. 1988); see also J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462, 18 USPQ 2d 1889 (Fed. Cir. 1991.)

The addition of a generic or descriptive word to a mark, such as "HACKETT", that has become a distinctive family name is insufficient to avoid a finding that the marks are similar. See TMEP 1207.01(b)(iii); see also Quality Inns Int'l, Inc., 695 F. Supp. at 221. Moreover, the degree of similarity between the marks needed to determine a likelihood of confusion declines where the services are - as is the case here -- legally identical. See, e.g., In re Mighty Leaf Tea,

601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); In re Max Capital Group Ltd., 93 USPQ2d 1243, 1246 (TTAB 2010). Registrant's HACKETT CONSULTING mark is a simple combination of Petitioner's distinctive "HACKETT" mark with a generic term that appears within the Registrant's identification of services. This was, in fact, why Registrant chose to include the term "consulting" in the first place. (A. Hackett Dep. 7:13-14) stemmed a "single descriptor". Moreover, "consulting" generically describes services that Petitioner has been offering for over twenty (20) years. Because HACKETT is the dominant element of both parties' marks, and as "consulting" simply describes both parties' services, consumers are unlikely to distinguish the source of services offered under HACKETT CONSULTING, on the one hand, and those offered under THE HACKETT GROUP and the HACKETT Marks, on the other. Consequently, the overall marks should be found similar in appearance, pronunciation, connotation and commercial impression. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)

B. Similarity of the Services.

As reflected in the HACKETT CONSULTING Registration, Registrant offers "*consulting, development, management and marketing of brands for businesses.*" Similarly, Petitioner offers "*business consultation and analysis services, namely, providing surveys and analysis reports in the nature of best practices and benchmarking of business processes.*" Registrant's principal has conceded that the recitation of services within the HACKETT CONSULTING Registration falls "squarely [within] what I was trying to do" (A. Hackett 13:4-5, 37:18-25-38:1-5.) Nevertheless, Registrant also attempts to draw distinctions

between the Registrant's and Petitioner's services based upon (1) the relative size of the parties; and (2) Registrant's tendency to focus on specific sub-categories of "brand management and consulting." Neither of these "distinctions", however, are reflected in the identification of services within THE HACKETT CONSULTING Registration and, therefore, have no bearing on this analysis. As noted in the Board's recent decision in In Katz Communications, Inc. v. Katz Marketing Solutions LLC:

[I]t is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be. Accordingly, because Registrant's services are broadly described in its identification, and because this broad identification of services can include consulting on the purchase of television and radio advertising spots, the identified services must be deemed to overlap with the consulting services in connection with the radio and television representation identified in opposer's registration.

See Opposition No. 91191178, at 30 (February 21, 2013) [not precedential] (internal citations omitted).

Here, Registrant's focus on "brands" is simply a niche practice area that falls squarely within the over-arching category of services offered by Petitioner. As the Board recently noted "[m]arketing consulting services are . . . very broad, and include product promotion." In Katz Communications Opposition No. 91191178, at 30 ; see also Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d at 1265, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (finding "data and information

process" similar to "consulting services, whether for data processing or for data processing products.")

Registrant's principal, for example, concedes that one facet of brand management involves taking "broad look at the competition [which] can tell you what trends are. It could be benchmarking." (A. Hackett Dep. 12:5-11, 43:13-19) (emphasis added). Registrant also concedes that benchmarking services fall within the scope of the HACKETT CONSULTING Registration. (A. Hackett Dep. 38:7-19). This is also a service reflected, verbatim, within THE HACKETT GROUP Registration's recitation of services, and a service Petitioner routinely offers its clients. (Snowball Dep. 10:16-24, 11:14-17, 12:1-2, 15:13-16, noting that "we provide an indication of whether [a client's] performance was strong or weak relative to the comparison that was used"). As Mr. Snowball testified, Petitioner regularly performs duties that can be considered "brand management", including: benchmarking the effectiveness of a client's marketing avenues (Snowball Dep. 44:12-23) and evaluating how effectively a client is driving traffic to its website, (Snowball Dep. 45:20-22), and working with clients to develop and improve websites. (Snowball Dep. 57:24-58:16). Similarly, if a weakness is identified, both parties may offer the client some prescriptive recommendations. Id.; see also (A. Hackett Dep. 55:7-18)

Services need not be identical or even competitive in order to find that they are related, rather the issue is whether consumers would confuse the source of the goods and service, not the goods and services themselves. In re Rexel Inc., 223 USPQ 830 (TTAB 1984).



Registrant's principal has conceded that his average client is not "that versed in even defining what brand management is." (A. Hackett Dep. 39:1-14). As such, comparing the services under each mark reveals more than enough similarities to find that consumers would be likely to assume that the services originate from the same source. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

C. Similarity of Trade Channels.

With regard to "the similarity or dissimilarity of established, likely-to-continue trade channels," the Petitioner's dominant role in the consulting industry, coupled with the broad nature of its services, ensures that Petitioner's channels of trade will envelop any channels in which Registrant might operate. Specifically, neither the HACKETT CONSULTING Registration nor THE HACKETT GROUP Registration contains any limitation as to the type of clientele or the nature of the business to which consulting services are rendered. Further, in rendering their services, both Petitioner and Registrant interact with higher-level executives, as well as individuals, such as brand managers and web developers, employed within a company's marketing department. (Snowball Dep. 24:22-25 - 25:1-3, 43:2-7); (A. Hackett Dep. 56:14-24, 57:13-18, 58:6-22); see also In Katz Communications Opposition No. 91191178, at 31 (discussing the potential "overlap in the personnel within a company that encounter the parties' services.") Both parties have testified that their client development are strongly skewed towards referrals sources and word-of-mouth testimony, often

from former clients. (Snowball Dep. 14:5-22); (A. Hackett Dep. 16:15-24). Consequently, this factor also weighs in Petitioner's favor.

D. Natural Zone of Expansion.

As discussed above, rather than representing a "distinct departure" from Petitioner's services, Registrant's services represent one facet of Petitioner's over-arching category of services. Additionally, strong similarities in the parties' channels of trade, as well as the class of customers whom they serve, ensures that the goodwill Petitioner in its mark would certainly carry over into Registrant's field of use. See, e.g., Evolutions Healthcare Sys. V. Evolution Bens., Inc., 2007 TTAB Lexis 240, \*25 (TTAB 2007). For this reason, Petitioner's field of use is certainly within Registrant's natural zone of expansion. See Mason Engineering and Design Corp. v. Mateson Chemical Corp., 225 USPQ 956, 962 (TTAB 1985).

E. The Absence of Similar Marks for Comparable Services.

The owner of an incontestable mark on the Principal Register, such as THE HACKETT GROUP, is entitled to a presumption that the mark is valid and distinctive. 15 U.S.C. §1057(b), §1115. Further, a review of the Principal and Supplemental Registries reveals only two active federal registrations claiming use of "HACKETT" in connection with services in Class 35, namely, THE HACKETT GROUP and HACKETT CONSULTING Registrations. Accordingly, this factor weighs in Petitioner's favor.

F. The Acclaim of the HACKETT Marks.

For over two decades, Petitioner has extensively used, advertised, and promoted THE HACKETT GROUP mark in connection with a

broad array of business services. Publicly traded under the ticker symbol "HCKT", Petitioner maintains offices throughout the world and has established a brand known to and used by the world's largest and most successful companies. Pet. Exs. 4, 24-27. As reported by the New York Times, Petitioner has - in conjunction with the HACKETT Marks - hosted conferences that have been attended by the world's most powerful executives. (Snowball Dep. 61:22-25, 62:1-25, 91-93:18-25, 94:1-15 and corresponding Exhibits 12 and 13.) In sum, public recognition of the HACKETT Marks and of Petitioner's dominant role in the consulting field was solidified long before the first use of HACKETT CONSULTING and, due to Petitioner's efforts, has only continued to grow since that time.<sup>2</sup>

#### V. CONCLUSION

As discussed above, U.S. Registration No. 3,878,276 for "HACKETT CONSULTING" is likely to cause confusion, mistake or deception as to the source of Registrant's services, as to Registrant's affiliation, connection, or association with Petitioner, and as to Petitioner's sponsorship or approval of Registrant's services.

Respectfully submitted,

Dated: February 6, 2014

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<sup>2</sup> Though Petitioner's analysis has been limited to "dispositive factors", Petitioner submits that the remaining DuPont factors either weigh in Petitioner's favor or are neutral.

**CERTIFICATE OF FILING**

I HEREBY CERTIFY that the foregoing document was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board, web site, www.uspto.gov, this 6th day of February 2014.

By: /Francisco J. Ferreiro/  
Francisco J. Ferreiro

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing document was sent by via E-mail and First Class Mail to the following on February 6, 2014:

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